

4-23-01

GP3743
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ATTORNEY DOCKET NO.
004578.1025

PATENT APPLICATION
09/397,481

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Application of: HAWS, et al.
Serial No.: 09/397,481
Filed: September 16, 1999
Group No.: 3743
Examiner: Atkinson, C.
Title: METHOD AND APPARATUS FOR COOLING
WITH A PHASE CHANGE MATERIAL AND
HEAT PIPES

RECEIVED
APR 27 2001

TC 3700 MAIL ROOM

Assistant Commissioner
for Patents
Washington, D.C. 20231

Dear Sir:

I hereby certify that this communication, is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on April 20, 2001, and is addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Willie Jiles

Willie Jiles
Express Mail Cert. No.
EL759178020US

LETTER RE INCOMPLETE OFFICE ACTION

The undersigned acknowledges receipt of the Office Action mailed April 12, 2001. However, the Office Action is incomplete, for reasons discussed below. It is noted that this is the second successive Office Action which is incomplete, for the same basic reasons.

The Office Action included "Office Action Summary" Form PTO-326, which indicates that the Office Action is accompanied by Form PTO-892 (Notice of Reference Cited).

However, the Office Action did not include a copy of Form PTO-892. Applicants are entitled to know which additional references are being cited in the present Office Action, even if those references are not specifically being relied on to reject the claims. Accordingly, it is respectfully requested that the Examiner provide a copy of the Form PTO-892 which was supposed to be a part of the present Office Action mailed on April 12, 2001. To the extent the Office Action was not accompanied by a copy of Form PTO-892, it is respectfully submitted that the Office Action is incomplete.

Form PTO-326 also indicated that it was accompanied by an enclosed Notice from the Official Draftsman (Form PTO-948). However, the Office Action was not actually accompanied by a copy of Form PTO-948. Applicants did receive a copy of Form PTO-948 with the prior Office Action (mailed August 15, 2000), but it is not clear whether the present Office Action is referring to this same Form PTO-948, or to a new Form PTO-948.

Attached to the pending Office Action are copies of a Form PTO-1449 (three sheets) filed by Applicants on February 8, 2000 with a first Information Disclosure Statement, and a copy of Form PTO-1449 (1 sheet) filed by Applicants on January 8, 2001 with a second Information Disclosure Statement. With respect to the copy of Form PTO-1449 filed on February 8, 2000, the Examiner has drawn a horizontal line through a total of seventeen different documents, in order to indicate that they have not been considered on the merits. Applicants respectfully object to the fact that these seventeen documents were not considered on the merits, for several reasons which are discussed separately below.

On a general level, the Examiner is asserting that, with respect to each of these seventeen documents, Applicants

failed to comply with some provision of 37 CFR §1.98. However, Applicants wish to make the Examiner aware of the fact that Applicants submitted an effectively identical Information Disclosure Statement in co-pending U.S. Serial No. 09/397,486 (filed September 16, 1999, Attorney Reference 004578.0851). In the co-pending application, each of the seventeen documents in question was readily considered on the merits, without any form of objection on the theory that the submission failed to comply with 37 CFR §1.98. To the extent that the PTO found the Information Disclosure Statement in the co-pending application to be in suitable compliance with §1.98, it is inconsistent for the PTO to indicate that the effectively identical Information Disclosure Statement submitted in the present application does not comply with §1.98.

Turning now in more detail to the specific grounds of objection set forth in the Office Action, the seventeen documents included a first document subset containing eleven of the seventeen documents, and the documents in this first subset were all subject to an objection under §1.98(a)(3), on the ground that they are non-English documents and were not accompanied by a concise explanation of relevance. One of these documents is European Publication No. 0 308 247, but this document is in the English language, and is thus not subject to the provisions of §1.98(a)(3). The European '247 publication should unquestionably have been considered on the merits. A second of these eleven documents is European Publication No. 0 541 546, which is in the French language. Applicants do not have a direct translation of the European '546 publication. However, as discussed in the Information Disclosure Statement filed on February 8, 2000, Applicants submitted (in lieu of a direct translation) a copy of U.S. Patent No. 5,404,272, which is a direct English-language

equivalent of the European '546 publication. U.S. Patent No. 5,404,272 is a sufficient English-language equivalent that the European '546 publication should have been considered on the merits.

The other nine of the eleven documents are each a Japanese reference with an attached English-language Abstract. It is respectfully submitted that the presence of the English-language Abstract should have been sufficient to avoid non-consideration of these documents, for the following reasons. When §1.98 was adopted in 1992, the final rule was published in the usual manner in the Federal Register (at 57 FR 2021-2036). The final rule included the following comments relating specifically to §1.98(a)(3):

Applicants should note, however, that most examiners do not have the ability to understand information which is not in English and that the Office will not routinely translate information submitted in a non-English language. The Examiner will consider the information insofar as it is understood on its face, e.g., drawings, chemical formulas, English-language abstracts, but will not have the information translated unless it appears to be necessary to do so.
57 FR 2031 (emphasis added).

In the present application, the Examiner has not complied with the stated PTO policy that the Examiner will consider the submitted information (Japanese documents with English-language abstracts) insofar as the information is understood on its face, for example based on any "English-language abstract" which is part of the information. For the foregoing reasons, it is respectfully submitted that the nine Japanese documents with English abstracts should not have been

completely ignored on the ground that their submission did not comply with §1.98(a)(3).

For the reasons set forth above, each of the eleven documents in the first document subset should have been accepted as properly submitted under §1.98(a)(3), and should have been considered on the merits in the manner appropriate under PTO policy.

Looking again to the seventeen documents that were not considered on the merits, a second document subset included five of the seventeen documents, as to which the Examiner indicated that they could not be considered on the merits because the Information Disclosure Statement failed to identify at least one of the inventor (i.e. "author"), publication date, company, and/or publisher. Applicants respectfully object to the fact that these five documents were not considered on the merits, for the following reasons. The Examiner was apparently relying on the last sentence of §1.98(b). However, the provisions of §1.98(b) do not apply to all documents, for the following reasons.

The provisions of §1.98(b) apply only to U.S. patents, foreign patents, published foreign applications, and publications. In contrast, the provisions of §1.98(a)(1) and §1.98(b) each show that §1.98 encompasses not only patents and publications covered by §1.98(b), but also "other information". One example of such "other information" is a U.S. patent application, which is mentioned in §1.98(a)(2)(iii), but which is not covered by §1.98(b). In fact, there are a variety of types of "other information" which fall within §1.98 but not within §1.98(b).

To the extent that Applicants have submitted documents in the present application which do not expressly set forth on their face all of the information required by §1.98(b), it is respectfully submitted that those documents

nevertheless qualify as "other information" that can properly be submitted under §1.98(a)(1). Consequently, each of the five documents in the second document subset should have been considered on the merits as "other information", regardless of the last sentence of §1.98(d).

Focusing again on the seventeen documents which were not considered on the merits, a third document subset includes one document, which is Nemes U.S. Patent No. 5,225,964. The Examiner refused to consider this document on the ground that Form PTO-1449 included a typographical error in the patent number for this document. However, the Information Disclosure Statement was accompanied by a copy of the Nemes patent, and there was thus no uncertainty about what patent was being submitted. The Examiner could have made a hand-written correction to the patent number for the Nemes patent on Form PTO-1449, and/or could have separately cited the Nemes patent on Form PTO-892. It is respectfully submitted that there is no reasonable basis for the Examiner's refusal to consider the Nemes patent on the merits.

The Information Disclosure Statement in question was filed more than a year ago (on February 8, 2000), and the accompanying documents still have not been properly considered on the merits. Applicants have taken the time and trouble to attempt to comply as fully as reasonably possible with the duty of disclosure and with the requirements of 37 CFR §§ 1.56, 1.97 and 1.98, and it is respectfully submitted that it is not reasonable for the Examiner to be insisting that Applicants have failed to comply with the duty of disclosure with respect to a large number of documents. This is particularly true in view of the fact that an effectively identical Information Disclosure Statement was accepted by the PTO as entirely proper in a related copending application. With respect to the documents which were not considered on the



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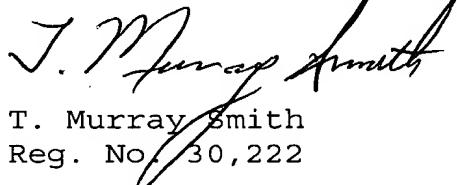
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Merits here, it is respectfully submitted that Applicants are entitled to have all of these documents considered on the merits before responding to any Office Action issued after the Information Disclosure Statement was filed. To the extent that the presently pending Office Action does not show these documents have all been considered on the merits, it is respectfully submitted that the Office Action is incomplete.

The Examiner is respectfully requested to: (1) withdraw the incomplete Office Action which was issued on April 12, 2001, (2) consider on the merits the documents that were filed with an Information Disclosure Statement on February 8, 2000 and that have not yet been considered on the merits, and (3) then issue a new Office Action which is accompanied by the missing Form PTO-892, and by a properly initialed copy of the relevant Form PTO-1449, showing consideration of all cited documents on the merits. For this purpose, and as a courtesy to the Examiner, a clean copy of the relevant Form PTO-1449 is enclosed.

Respectfully submitted,
BAKER BOTTS L.L.P.
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Date: April 20, 2001

Enclosures: Clean copy of Form PTO-1449
filed February 8, 2000
Acknowledgment Post card

PTO-1449

Application No.

09/397,481

Applicant(s)

Haws, et al.

Docket Number

004578.1025

Group Art Unit

Unknown

Filing Date

09/16/99

Information Disclosure Citation
in an Application

APR 28 2001

U.S. PATENT DOCUMENTS

DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS	FILING DATE
A 2,677,367	05/04/54	M. Telkes			
B 3,132,688	05/12/64	W. B. Nowak			
C 3,909,118	09/30/75	Schmidt			
D 4,047,198	09/06/77	Sekhon, et al.			
E 4,099,853	07/11/78	Glickler, et al.			
F 4,143,946	03/13/79	Leo, et al.			
G 4,178,727	12/18/79	Prusinski, et al.			
H 4,268,558	05/19/81	Boardman			
I 4,341,262	07/27/82	Alspaugh			
J 4,381,818	05/03/83	Sachar, et al.			
K 4,408,659	10/11/83	Hermanns, et al.			
L 4,446,916	05/08/84	Hayes			
M 4,494,171	01/15/85	Bland, et al.			

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FOREIGN PATENT DOCUMENTS

DOCUMENT NO.	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
					YES	NO
A 0 308 247	03/22/89	EPC				
B 2-208497	8/90	Japan			Abstract	
C 55-96892	7/80	Japan			Abstract	
D 1-147294	6/89	Japan			Abstract	
E 60-232496	11/85	Japan			Abstract	

NON-PATENT DOCUMENTS

	DOCUMENT (Including Author, Title, Source, and Pertinent Pages)	DATE
F	Gaunt, et al., IBM Technical Disclosure Bulletin, XP 002045948 "Low Velocity Air-Jet Cooling", Vol. 25, No. 7A, December 1982, pp 3305 and 3306.	
G	IBM Technical Disclosure Bulletin, XP 000584055 "Multi-Chip Module Impingement Cooling Plenum", Vol. 39, No. 05, May 1996, pp 57 and 58.	
H	XP 002045949, "IBM Packs in High Density Circuits", Computer Design, December 1984, pp. 254 and 255.	

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.

PTO-1449 Information Disclosure Citation in an Application <i>APR 20 2001</i>			Application No. 09/397,481	Applicant(s) Haws, et al.		
			Docket Number 004578.1025	Group Art Unit Unknown	Filing Date 09/16/99	
U.S. PATENT DOCUMENTS						
PARENT & TRADEMARK OFFICE	DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS	FILING DATE
	A 4,512,388	04/23/85	Claar, et al.			
	B 4,528,208	07/09/85	Hirvonen, et al.			
	C 4,730,233	03/08/88	Osterman			
	D 4,832,118	05/23/89	Scanlon, et al.			
	E 4,823,863	04/25/89	Nakajima, et al.			
	F 4,898,234	02/06/90	McGovern, et al.			
	G 4,966,226	10/30/90	Hamburgen			
	H 4,998,181	03/05/91	Haws, et al.			
	I 5,007,478	04/16/91	Sengupta			
	J 5,039,577	08/13/91	Knoell, et al.			
	K 5,063,476	11/05/91	Hamadah, et al.			
	L 5,123,982	06/23/92	Kuzay			
	M 5,128,689	07/07/92	Wong, et al.			
	N 5,255,964	07/06/93	Nemes			
FOREIGN PATENT DOCUMENTS						
	DOCUMENT NO.	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION
						YES
	A 4-143526	5/92	Japan			Abstract
	B 6-291480	10/94	Japan			Abstract
	C 4-44352	2/92	Japan			Abstract
	D 63-267890	11/88	Japan			Abstract
	E 0 541 456 A1	5/93	EPC			X
NON-PATENT DOCUMENTS						
		DOCUMENT (Including Author, Title, Source, and Pertinent Pages)				DATE
	F	Rosenbaum, et al., "Efficient and Simple Heat Exchangers", 1981, pp. 593-594.				
	G	"Sketch A - Mechanical and Electrical Packaging of 'Slat' Phased Arrays" (1 sheet).				
	H	"Development of Advanced EHF Airborne Arrays", Ft. Monmouth, NJ; May 2, 1995 (13 sheets).				
EXAMINER				DATE CONSIDERED		
EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.						